

REMARKS

Reconsideration and the timely allowance of the pending claims, in view of the following remarks, are respectfully requested.

By this Amendment, claims 1, 2, 7-9, 11, and 13 have been amended to provide a clearer presentation of the claimed subject matter. Claims 15-17 have been newly added. Claims 5, 10, and 12 have been cancelled, without prejudice or disclaimer. Claim 14 was previously cancelled. Applicant submits that no new matter has been introduced. As such, claims 1-4, 6-9, 11, 13, and 15-17 are presented for examination of which claims 1, 2, 8, and 15 are independent.

By this Amendment, the specification has been amended to better describe the present invention without adding new matter. The amendments have been made remove any ambiguities with respect to the meaning of “mode”. Specifically, page 5, lines 16-32 of the Specification has been amended to clarify that the mobile station can be in three different states, ready, standby or idle states. As such, per various embodiments of the present invention, a multimode mobile station may be registered in a telecommunications system that supports different networks (e.g., packet-switched network, circuit-switched network), wherein one *mode* of the multimode mobile station supports the circuit-switched network and another *mode* supports the packet-switched network.

REJECTIONS UNDER 35 U.S.C. § 101

Claims 8-12 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Without acknowledging the propriety of the rejection and solely in an effort to expedite prosecution, claims 8, 9, and 11 have been amended. Applicant submits that claim 8 recites statutory subject matter and that “registering a multimode mobile station in a telecommunications system” includes a practical application that produces tangible, concrete and useful result.

As such, the withdrawal of these rejections is earnestly solicited.

REJECTIONS UNDER 35 U.S.C. § 103

The Examiner rejected claims 8-10, 11 and 12 under 35 U.S.C. §103(a), as allegedly being unpatentable over Amin (U.S. Patent No.6,560,455) in view of Nordman (U.S. Patent No.6,061,346); and rejected claims 1-7, 11 and 13, under 35 U.S.C. §103(a), as allegedly being unpatentable over Josse (U.S. Patent No.6,104,929) in view of Amin and Nordman.

Applicant respectfully traverses the prior art rejections, under 35 U.S.C. §103(a), because the Examiner has failed to establish a *prima facie* case of obviousness. The references relied upon by the Examiner, either alone or in combination with one another, fail to teach or suggest each of the features of Applicant's pending claims.

i) Josse, Amin, and Nordman, either alone or in combination, fail to teach or suggest "registering of a **multimode mobile station** in a telecommunications network that supports a first network and a second network, wherein the first network and a second network are of different type".

Applicant's pending independent claims 1, 2, 8, and 15 positively recite the above-mentioned feature of: registering of a **multimode mobile station** in a telecommunications network that supports a first network and a second network, wherein the first network and a second network are of different type.

Neither Josse, Amin, or Nordman, either alone or in combination with one another, disclose, teach or suggest, registering of a **multimode mobile station**, wherein for example, one mode of the multimode mobile station supports a first network (e.g. a packet-switched network) and another mode supports a second network (e.g. a circuit-switched network), the first and second network being of different type (see also, dependent claims 7, 11, 13, 17). As such, there is no mention whatsoever in the corresponding references (Josse, Amin and Nordman), that the mobile station 40 of Josse; mobiles 5, 10, 20 and 30 of Amin; and GSM mobile terminal 16 of Nordman, are multimode mobile stations, wherein at least two modes of the multimode mobile station are capable of supporting first and second networks of different type.

For at least the above-mentioned reasons, claims 1, 2, 8, and 15 are clearly patentable over Josse, Amin, and Nordman. And, because claims 3-4, 6-7, 9, 11, 13, and 16-17 depend from one of claims 1, 2, 8, or 15, either directly or indirectly, claims 3-4, 6-7, 9, 11, 13, and

16-17 are patentable at least by virtue of dependency as well as for their additional recitations.

ii) *Claims 8-10, 11 and 12 are not obvious over Amin in view of Nordman.*

In addition to the features identified above in section i), Amin and Nordman, either alone or in combination with one another, fail to disclose, teach or suggest at the following feature of Applicant's claim 8: *subscriber-specific access parameter* which indicates, *independently of the address information, whether the mobile subscriber is entitled to use the first network, the second network or both networks*.

Amin merely discloses a subscriber's profile, which indicates whether roaming privileges are restricted for the MIN/ESN pair. At best, Amin indicates subscriber's roaming restrictions *per MSC area* (rrm fields). In contrast, per various embodiments of Applicant's claimed invention, the subscriber-specific access parameter indicates a subscriber's entitlement to use a *first network*, a *second network*, or *both networks*.

Furthermore, Nordman fails to cure the deficiencies of Amin identified above. Thus, for at least these reasons, Applicant submits that none of the asserted references, whether taken alone or in reasonable combination, teach or suggest the claimed combination of elements recited by amended claim 8. As such, claim 8 is clearly patentable. And, because claims 9 and 11 depend from claim 8, either directly or indirectly, claims 9 and 11 are patentable at least by virtue of dependency as well as for their additional recitations. Accordingly, the immediate withdrawal of the prior art rejections of claims 8, 9 and 11 is respectfully requested.

iii) *Claims 1-7, 11 and 13 are not obvious over Josse in view of Amin and Nordman.*

In addition to the features identified above in section i), Josse, Amin and Nordman, either alone or in combination with one another, fail to disclose, teach or suggest at least the following features of Applicant's claim 1: maintaining a *subscriber-specific access parameter* which indicates, *independently of the address information, whether the mobile subscriber is entitled to use the first network, the second network or both networks*; in response to said message for requesting the subscriber data, *the home location register sending the mobile subscriber data and also said subscriber-specific access parameter*; and whereby *the network element that requested the mobile subscriber data is operable to use*

said subscriber-specific access parameter for restricting the access of the mobile subscriber only to the first network or to the second network.

Preliminarily, Applicant wishes to note that Figure 3A in Josse appears to be similar to as-filed Figure 2 of Applicant's application. The Examiner appears to reject Applicant's pending claims based on Josse's text in columns 7 and 8 relating to Figures 3 (which is a general signal flow for combined IMSI/GPRS attach procedure) and 3A (which is a more detailed diagrammatic flow of the same procedure). However, Applicant's Figure 2 illustrates registration of a mobile station in the system according to PRIOR ART (see page 8, lines 5, 6 of as-filed Specification). In other words, Josse's signal flow(s) that the Examiner is referring to reject Applicant's claims is Applicant's admitted prior art (A.A.P.A.).

The Examiner, at page 5 of the Office Action, admits that "Josse et al does not specifically teach a subscriber-specific access parameter and independently of address information". However, the Examiner erroneously relies on Amin for this feature (col. 6, line 33-col. 7, line 17. However, in actuality, Amin merely discloses a subscriber's profile, which indicates whether roaming privileges are restricted for the MIN/ESN pair. At best, Amin indicates subscriber's roaming restrictions *per MSC area* (rrm fields). In contrast, per various embodiments of Applicant's claimed invention, the subscriber-specific access parameter indicates a subscriber's entitlement to use a *first network*, a *second network*, or *both networks*.

At column 7, lines 26-33, Josse discloses Insert Subscriber Data (ISD) procedures being initiated by the HLR. Furthermore, column 9, lines 13-20 of Josse also discloses that an Insert Subscriber Data (ISD) message that includes subscription data is sent by HLR. The subscription data included in the ISD message is depicted in Tables 1 and 2. Clearly, this subscription data does not include the alleged access parameter (e.g., MS class; see Office Action at page 4), much less, a subscriber-specific access parameter which indicates, indicates independently of the address information, whether the mobile subscriber is entitled to use the first network, the second network, or both networks (as admitted by the Examiner). In fact, column 7, line 65 to column 8, line 5, clearly states that the MS class parameter is included in the Attach Request message initiated by the mobile station. Thus, Josse fails to disclose, teach or suggest *the home location register sending the mobile subscriber data and also said subscriber-specific access parameter*.

As mentioned above, since Josse's HLR does not disclose sending the alleged access parameter to the network element that requested the mobile subscriber data, the network

element cannot use the alleged access parameter for restricting the access of the mobile subscriber only to the first network or to the second network. In fact, none of the parameters mentioned in Josse can be used to restrict access of mobile subscriber only to the first network or the second network. As such, Josse fails to disclose, teach or suggest, that *the network element that requested the mobile subscriber data is operable to use said subscriber-specific access parameter for restricting the access of the mobile subscriber only to the first network or to the second network.*

Moreover, Amin at column 6, lines 40-45 discloses that upon receiving a registration invoke signaling message, HLR 66 uses the MIN/ESN pair of the mobile 30 to retrieve the subscriber's profile associated with that mobile and that *HLR 66 determines whether roaming privileges are restricted for the received MIN/ESN pair.* Assuming arguendo, that Amin's subscriber profile with rrm fields is the same as Applicant's subscriber-specific access parameter (which Applicant does not concede), Amin still fails to disclose that HLR 66 sends the subscriber's profile to a network element, much less, that the network element uses the subscriber's profile sent by the HLR 66 for restricting the access of the mobile subscriber only to the first network or to the second network.

Furthermore, Nordman fails to cure the deficiencies of Josse and Amin identified above. Thus, for at least these reasons, Applicant submits that none of the asserted references, whether taken alone or in reasonable combination, teach or suggest the claimed combination of elements recited by amended claim 1. As such, claim 1 is clearly patentable. And, because claims 3-4, 6, and 7 depend from claim 1, either directly or indirectly, claims 3-4, 6, and 7 are patentable at least by virtue of dependency as well as for their additional recitations. Accordingly, the immediate withdrawal of the prior art rejections of claims 1, 3-4, 6, and 7 is respectfully requested.

Applicant further submits that because independent claims 2 recites similar patentable features as claim 1, claim 2 is also patentable for the same reasons given relative to claim 1. And, because claim 13 depends from claim 2, claim 13 is patentable at least by virtue of dependency as well as for their additional recitations. Accordingly, immediate withdrawal of the prior art rejections of claims 2 and 13 is respectfully requested.

iv) *Dependent Claims 7, 11, 13, and 17 are not obvious over Josse, Amin and Nordman.*

As mentioned above, with respect to section i), Josse, Amin and Nordman, either alone or in combination with one another, fail to disclose, teach or suggest that one mode of the multimode mobile station supports a packet-switched network and another mode supports a circuit-switched network. Thus, these claims are patentable for these additional reasons as well.

v) *Dependent Claim 9 and 16 are not obvious over Amin and Nordman.*

Amin and Nordman, either alone or in combination with one another, fail to disclose, teach or suggest that the first and second networks share a common home location register. Amin relates to roaming, which refers to moving to a network provided by an operator other than the subscriber's home operator. As such, the roaming operator needs to have a HLR separate from the home operator's HLR. Thus, Amin fails to disclose that the first and second networks share a common home location register. Nordman fails to cure the deficiencies of Amin. Thus, claims 9 and 16 are patentable for these additional reasons as well.

NEWLY ADDED CLAIMS 15-17

With regard to the newly added claims, independent claim 15 recites similar patentable features as claims 1 and 2, so claim 15 is also patentable for the reasons presented relative to claims 1 and 2. And, because claims 16-17 depend from claim 15, claims 16-17 are patentable at least by virtue of dependency as well as for their additional recitations.

CONCLUSION


All matters having been addressed and in view of the foregoing, Applicant respectfully requests the entry of this Amendment, the Examiner's reconsideration of this application, and the immediate allowance of all pending claims.

Applicant feels that the Examiner, in various Office Actions, has been vague in presenting his arguments and citations in the relied upon prior art. Thus, it has always been difficult to map the relied upon prior art to the various features of Applicant's pending claims. Applicant has also conducted Examiner interviews and presented various amendments in hopes of expediting the prosecution of this case. Applicant respectfully requests the Examiner to consider the amendments, arguments presented above and contact the undersigned at the telephone number listed below to discuss any further points that remain in issue to expedite prosecution of this case.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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